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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/399,083

09/17/1999

DAVID CALDERWOOD

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1842

7590 08/24/2007
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EXAMINER

RAO, DEEPAK R

ART UNIT	PAPER NUMBER
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1624

MAIL DATE	DELIVERY MODE
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08/24/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/399,083

Applicant(s)

CALDERWOOD ET AL.

Examiner

Deepak Rao

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10, 11, 46 and 48-52 are pending in the application.
- 4a) Of the above claim(s) 1-8, 10, 11 and 48-51 are withdrawn from consideration.
- 5) ☒ Claim(s) 52 is/are allowed.
- 6) ☒ Claim(s) 46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

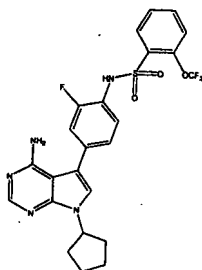
DETAILED ACTION***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 21, 2007 has been entered.

Claims 1-8, 10-11, 46 and 48-52 are pending in this application.

Election/Restrictions

Applicant's elected the species: N-(4-(4-amino-7-cyclopentyl-7H-pyrrolo[2,3-d]pyrimidin-5-yl)-2-fluorophenyl)-2-(trifluoromethoxy)-1-benzenesulfonamide in the response filed on May 7, 2001. The species is depicted below for convenience:



The species reads on claims 46 and 52.

As per the guidelines provided in MPEP § 803.02, upon examination if prior art is found for the elected species, the examination will be limited to the elected species. Accordingly, the Markush-type claims are examined to the extent readable on the elected species.

Content of MPEP § 803.02 is provided here for convenience:

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As an example, in the case of an application with a Markush-type claim drawn to the compound C-R, wherein R is a radical selected from the group consisting of A, B, C, D and E, the examiner may require a provisional election of a single species, CA, CB, CC, CD or CE. The Markush-type claim would then be examined fully with respect to the elected species and any species considered to be clearly unpatentable over the elected species. If on examination the elected species is found to be anticipated or rendered obvious by prior art, the Markush-type claim and claims to the elected species shall be rejected, and claims to the non-elected species would be held withdrawn from further consideration. As in the prevailing practice, a second action on the merits on the elected claims would be final.

On the other hand, should no prior art be found that anticipates or renders obvious the elected species, the search of the Markush-type claim will be extended. If prior art is then found that anticipates or renders obvious the Markush-type claim with respect to a nonelected species, the Markush-type claim shall be rejected and claims to the nonelected species held withdrawn from further consideration. **The prior art search, however, will not be extended unnecessarily to cover all nonelected species.** Should applicant, in response to this rejection of the Markush-type claim, overcome the rejection, as by amending the Markush-type claim to exclude the species anticipated or rendered obvious by the prior art, the amended Markush-type claim will be reexamined. The prior art search will be extended to the extent necessary to determine patentability of the Markush-type claim. In the event prior art is found during the reexamination that anticipates or renders obvious the amended Markush-type claim, the claim will be rejected and the action made final. Amendments submitted after the final rejection further restricting the scope of the claim may be denied entry.

As the elected species was not found in the prior art, the search was expanded to another species of claim 46, N-(4-(4-amino-7-cyclopentyl-7H-pyrrolo[2,3-d]pyrimidin-5-yl)-2-chlorophenyl)-4-chloro-1-benzenesulfonamide, and art was found. Claims 1-8, 10-11 and 48-51 are withdrawn from consideration as being drawn to nonelected inventions (see MPEP § 803.02).

Priority

It is acknowledged that the instant application is a CIP of 09/042,702 filed March 17, 1998 (which claims benefit of Provisional application 60/040,836 filed March 19, 1997) claims benefit from U.S. Provisional Application No. 60/100,834 and 60/100,954 filed September 18, 1998. It is noted however, that the instant claims are not entitled for the priority benefit because the instant claims are not fully supported in the prior application. Therefore, the effective filing date for the instant claims is September 17, 1997. See MPEP § 706.02.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

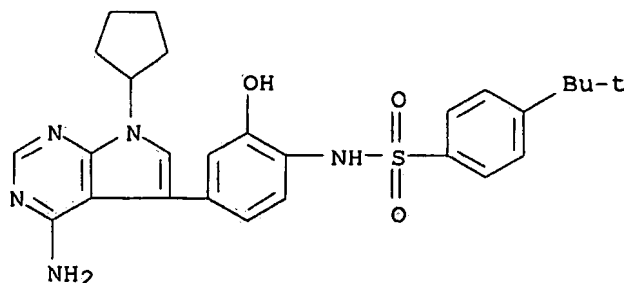
Claim 46 is rejected under 35 U.S.C. 103(a) as being unpatentable over Calderwood et al., WO 98/41525. The reference teaches a generic group of compounds which embraces applicant's instantly claimed compounds. See formula I in page 2 wherein R₃ is represented by formula (a) wherein the phenyl ring of formula (a) is optionally further substituted (see page 3, lines 6-9); A is NHSO₂ (page 3, line 10) and R₅ is optionally substituted phenyl. The reference further discloses several species that fall within the above genus, see pages 10-14, particularly page 14, lines 9-14 and 22-23. The compounds are taught to be useful as pharmaceutical therapeutic agents having protein kinase inhibition activity, see the entire document. The claims differ from the reference by reciting specific species of the reference genus.

For example, the reference discloses the following compound (see page 14, lines 13-14):

N[4-(4-amino-7-cyclopentyl-7H-pyrrolo[2,3-d]pyrimidin-5-yl)-2-hydroxyphenyl]***-4-tert-***
butylbenzenesulphonamide

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The structural formula of the compound is depicted below for convenience:



As can be seen from the above, the species claimed in claim 46 differs by the substituents on the phenyl rings. For example, a species of claim 46 - N-(4-(4-amino-7-cyclopentyl-7H-pyrrolo[2,3-d]pyrimidin-5-yl)-2-chlorophenyl)-4-chloro-1-benzenesulfonamide, differs by having a chloro substituent on each of the phenyl rings in place of the hydroxyl and t-butyl substituents disclosed for the reference compound. The reference further teaches the equivalency of the substituents halo, hydroxyl, alkyl, etc. as these substituents are taught as alternatives on the phenyl ring, see the definition provided for 'optionally substituted phenyl' in page 5, lines 1-11.

It would have been obvious to one having ordinary skill in the art at the time of the invention to select any of the species of the genus taught by the reference, including those instantly claimed, because the skilled chemist would have the reasonable expectation that any of the species of the genus would have similar properties and, thus, the same use as taught for the genus as a whole i.e., as pharmaceutical therapeutic agents. One of ordinary skill in the art would have been motivated to select the claimed compounds from the genus in the reference since such compounds would have been suggested by the reference as a whole. It has been held

that a prior art disclosed genus of useful compounds is sufficient to render prima facie obvious a species falling within a genus.

Applicant relies on the amendment to claim 1 wherein the definition of L has been amended to delete many of the terms disclosed in the reference. This is not, however, sufficient to overcome the rejection of claim 46 because the claim continues to be drawn to compounds having a sulfonamide linker (i.e., -NH-SO₂-) between the two phenyl rings of Ring A and R₃.

Next, applicant argues that the more preferred embodiments are drawn to compounds wherein A is O or S and therefore, the reference teaches away from the genus claimed by the instant application. This is not found to be persuasive because the reference teaches a genus which encompasses the species of the instant claim and further, expressly discloses compounds falling within the genus, see for example, the compound disclosed in page 14, lines 13-14 (structural formula shown above). One of ordinary skill in the art in possession of the reference compound, having a hydroxyl or lower alkyl substituents on the phenyl rings, would have immediately recognized that the substituents could be replaced with another substituent which is taught to be equivalent, such as halo, e.g., chloro (Cl) substituent, without loss of the pharmaceutical activity disclosed for the reference compounds.

Allowable Subject Matter

Claim 52 is allowed. The closest reference of record, WO 98/41525 does not teach or fairly suggest the instantly claimed compound wherein the phenyl ring of R₃ has a 2-trifluoromethoxy substituent.

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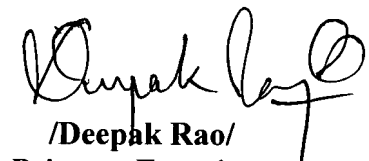
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deepak Rao whose telephone number is (571) 272-0672. The examiner can normally be reached on Monday-Friday from 8:00am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson, can be reached at (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


**/Deepak Rao/
Primary Examiner
Art Unit 1624**

August 17, 2007